

## **REMARKS**

Claims 1-55 are pending. In an Office Action mailed April 6, 2007, all the claims were rejected under 35 U.S.C. §102(e) or §103(a) over Roth (U.S. Patent No. 6,285,987). These rejections are respectfully traversed.

### **35 U.S.C. §102 Rejections**

Claim 1 recites, *inter alia*, selecting advertising content for display **based upon the received feedback on prior activities of the user** at the advertiser Web site. Independent claims 19, 37 and 55 recite similar features.

The Office Action asserts that Roth teaches this feature at column 2, lines 11-37. Roth describes characteristics of a “view-op” that include characteristics of a viewer, such as demographic information and other sites the viewer has accessed. *See* col. 2, lines 11-19. Advertisers submit bids based on the characteristics of each view-op. Col. 2, lines 20-47. The advertising web server then selects the highest bid and displays an advertisement specified by the bid:

[T]he bid selection logic selects the highest bid from the various available bids and **the advertisement which is specified in the highest bid is displayed.**

Col. 2, lines 58-60 (emphasis added); *see also*, col. 2, lines 48-53; col. 4, lines 26-43; and col. 5, lines 33-35. Thus, Roth’s system selects an advertisement **based on a bid** associated with the advertisement.

Notably, Roth’s advertising web server only considers the values of submitted bids when selecting an advertisement is the bid submitted by a bidder. There is no suggestion that the advertising web server uses other criteria in selecting the advertisement to be displayed. Specifically, Roth does not use the characteristics of the viewer to select the advertisement; the viewer characteristics are only used to solicit bids from advertisers, **not** to select the bid to be shown to a user. Thus, even if Roth’s viewer characteristics are interpreted as feedback on prior activities of the user as recited in the claims, which Applicants do not concede, Roth does not

teach or suggest selecting advertising content for display **based upon the received feedback on prior activities of the user**. For at least this reason, Roth fails to anticipate or render obvious the claims. The dependent claims are allowable for at least the same reasons as the independent claims, and withdrawal of the rejections is respectfully requested.

### **35 U.S.C. §103 Rejections**

The Office Action rejects claims 3, 4, 12-17, 21, 22, 30-35, 39-40, and 48-53 as unpatentable over Roth in view of Official Notice that email, FTP, customer reminders, coupons, and thank-you messages were well-known at the time the present invention was made. However, no evidence is supplied to suggest that these features were known or used in a field related to the claims, such as online advertising, as opposed to being known merely for conventional communication or shopping.

The Office Action also provides no suggestion of why one of skill in the art would combine the noted features in the manner suggested. For example, even if customer reminders and thank-you messages were well-known at the time the invention was made, the Office Action has not indicated why it would be obvious for a re-targeted advertisement to be a reminder or thank-you message specifying an advertiser Web site as recited in claim 15, or why one of skill in the art would make such a modification. Applicants respectfully request clarification of the features for which Official Notice is taken, and how such features are interpreted relative to the claims. Applicants also request that, if Examiner intends to take Official Notice that these features were well-known with respect to internet advertising and/or in the combinations suggested in the Office Action, that documentary evidence of such be provided with the next Office Action.

The Office Action fails to show that the suggested combinations would have been obvious to one of skill in the art. Therefore, dependent claims 3, 4, 12-17, 21, 22, 30-35, 39-40, and 48-53 are patentable over the cited art. Withdrawal of the rejections and reconsideration is respectfully requested.

### **Information Disclosure Statement**

An Information Disclosure Statement (IDS) was filed on August 14, 2006. Applicants have not received an indication that the references cited in the IDS have been considered by the Examiner. It is respectfully requested that, with the next communication from the Office, the Examiner provide a copy of the IDS indicating that the references have been considered.

### **Conclusion**

Based on the above remarks, Applicants believe the claims are in condition for allowance. The Commissioner is authorized to charge any fees or credit any overpayment to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned to discuss any matter concerning this application.

Respectfully submitted,

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